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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/954,823  
Filing Date: September 18, 2001  
Appellant(s): BEERY, EDWARD L.

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Jed W. Caven  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on January 12, 2007 appealing from the Office action mailed on July 18, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 9-23, 25, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al. (US 6,055,513).

Claim 9: Katz et al. discloses a computer-based method for presenting one or more promotions, comprising:

- a. receiving, in a computing system, a signal identifying a first product associated with an order (col 15, lines 38-65 and col 22, lines 31-45);
- b. associating a first product identifier with the first product (col 24, lines 31-49);
- c. presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21).

Claim 10: Katz et al. discloses the method of claim 9, wherein presenting, via a user interface, one or more promotions comprises determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier (col 23, line 62 to col 25, line 55).

Claim 11: Katz et al. discloses the method of claim 10, wherein determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier comprises comparing the first product

Art Unit: 1796

identifier with a list of product identifiers associated with promotional offers (col 23, line 62 to col 25, line 55).

Claim 12: Katz et al. discloses the method of claim 9, wherein a promotion is associated with a combination of one or more product identifiers (col 23, line 62 to col 25, line 55).

Claim 13: Katz et al. discloses the method of claim 9, further comprising presenting one or more replacement products in the user interface (col 23, line 62 to col 25, line 55).

Claim 14: Katz et al. discloses the method of claim 9, further comprising receiving, in the computing system, a signal requesting processing for one or more promotions (col 23, line 62 to col 25, line 55).

Claim 15: Katz et al. discloses the method of claim 14, further comprising replacing the first product with the second product when a replacement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

Claim 16: Katz et al. discloses the method of claim 14, further comprising adding another product to the order when an enhancement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

Claims 17-22 disclose the computer program on a readable medium of the method Claims 9-16 respectively. The prior art of Katz et al. as set forth above in Claims 9-16 is upon to reject Claims 17-22.

Art Unit: 1796

Claim 23: Katz et al. discloses a computer-based method of delivering a promotional offer to a consumer, comprising:

- a. storing criteria for a promotional offer in a computer-readable memory (col 15, lines 38-65 and col 22, lines 31-45);
- b. receiving, in a computing system, a signal identifying a first product associated with a consumer order (col 15, lines 38-65; col 22, lines 31-45 and col 24, lines 31-49);
- c. comparing a first product identifier associated with the first product with the criteria for a promotional offer (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21); and
- d. presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21).

Claim 25: Katz et al. discloses the method of claim 23, further comprising:

- a. receiving, in the computing system, a signal requesting processing for one or more promotions (col 22, lines 31-45 and col 23, line 62 to col 25, line 55);
- b. replacing the first product with the second product when a replacement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55); and
- c. adding another product to the order when an enhancement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

Claims 26 and 28 disclose the computer program on a readable medium of the method Claims 23 and 25 respectively. The prior art of Katz et al. as set forth above in Claims

Art Unit: 1796

23 and 25 is upon to reject Claims 26 and 28.

2. Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US 6,055,513).

Claim 24: Katz et al. discloses the method of claim 23, but does not explicitly disclose wherein storing criteria for a promotional offer in a computer-readable memory comprises associating the first product identifier with one or more promotional codes. Katz recites the use of promotional offers in the field of upselling and cross-marketing (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Katz et al., with the use of promotional codes since it was known in the art that promotions are identified by codes to provide a way of tracking the promotions.

Claim 27 discloses the computer program on a readable medium of the method Claims 24. The prior art of Katz et al. as set forth above in Claim 24 is upon to reject Claim 27.

#### **(10) Response to Argument**

A. Response to the Board Remand dated 09/29/2008.

The Board has requested a claim construction analysis and mapping of the claims.

Claim 9: Katz et al. discloses a computer-based method for presenting one or more promotions, comprising:

a. receiving, in a computing system, a signal identifying a first product associated with an order;

Art Unit: 1796

- b. associating a first product identifier with the first product;
- c. presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.

Claim 9 is directed to a method of presenting to a user promotion for a second product based on the association with a first product. This method is recognized in the art as being a cross-marketing or upsell approach to marketing. Katz et al. teach the overall computer network infrastructure (col 15, lines 38-65) for presenting an upsell system of a secondary product based on the primary product (col 13, lines 38-47: "The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as where an initial contact is for service or repair purposes."). Katz et al. disclose the procedural steps of retrieving information about the primary transaction then offering an upsell or discount from a database of offers (col. 17, line 54 to col 18, line 15).

Claim 10: Katz et al. discloses the method of claim 9, wherein presenting, via a user interface, one or more promotions comprises determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.

Claim 10 is directed to the determination of the promotion based on the primary product. Katz et al. teach various criteria in choosing the upsell offers to maximize the



Art Unit: 1796

the likelihood of upsell (col 24, line 2) such as complements or upgrades to prior sales (col 23, line 60 and col 24, lines 31-49).

Claim 11: Katz et al. discloses the method of claim 10, wherein determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier comprises comparing the first product identifier with a list of product identifiers associated with promotional offers.

Claim 11 is directed to a comparison to a list of product identifiers associated with offers. Katz et al. teach the feature of selecting offers from a database of available offers based on the primary transaction (col 23, lines 40-60). It is inherent that a database entry would have an identifier.

Claim 12: Katz et al. discloses the method of claim 9, wherein a promotion is associated with a combination of one or more product identifiers

Claim 12 is directed to a combination within a list of product identifiers associated with offers. Katz et al. teach the feature of selecting a subset of possible goods as offers from a database of available offers based on the primary transaction (col 23, lines 40-60 and col 23, line 67 to col 24, line 1). It is inherent that each database entry would have an identifier.

Claim 13: Katz et al. discloses the method of claim 9, further comprising presenting one or more replacement products in the user interface.

Claim 13 is directed to replacement product as the offer. Katz et al. teach the feature of a replacement product such as a new version of the software (col 24, line 45).

Art Unit: 1796

Claim 14: Katz et al. discloses the method of claim 9, further comprising receiving, in the computing system, a signal requesting processing for one or more promotions.

Claim 14 is directed to the processing of the offer or promotion. Katz et al. teach the feature of presenting the offer in a website setting and consummating the order (col 25, line 10-12 and col 25, line 56). The signal is inherent, for example, the accessing a database is a signal and selecting an offer is a signal.

Claim 15: Katz et al. discloses the method of claim 14, further comprising replacing the first product with the second product when a replacement promotion is selected.

Claim 15 is directed to a replacement product offer. Katz et al. teach the feature of a replacement product such as a new version of the software (col 24, line 45).

Claim 16: Katz et al. discloses the method of claim 14, further comprising adding another product to the order when an enhancement promotion is selected.

Claim 16 is directed to adding another product for an enhancement promotion. Katz et al. teach the feature of offering upgraded based on prior purchase such as additional memory for a computer system (col 24, line 37-43).

Claims 17-22 disclose the computer program on a readable medium of the method Claims 9-16 respectively. The prior art of Katz et al. as set forth above in Claims 9-16 is upon to reject Claims 17-22.

Art Unit: 1796

Claim 23: Katz et al. discloses a computer-based method of delivering a promotional offer to a consumer, comprising:

- a. storing criteria for a promotional offer in a computer-readable memory ;
- b. receiving, in a computing system, a signal identifying a first product associated with a consumer order ;
- c. comparing a first product identifier associated with the first product with the criteria for a promotional offer; and
- d. presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.

Claim 23 is directed to a method of presenting to a user promotions for a second product based on the association with a first product in a computer architecture. This method is recognized in the art as being a cross-marketing or upsell approach to marketing. Katz et al. teach the overall computer network infrastructure (col 15, lines 38-65) for presenting an upsell system of a secondary product based on the primary product (col 13, lines 38-47: "The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as where an initial contact is for service or repair purposes."). Katz et al. disclose the procedural steps of retrieving information about the primary transaction stored on a database then offering an upsell from a database of offers (col. 17, line 54 to col 18, line

Art Unit: 1796

39). Katz et al. teach the use of web interface and computer network architecture (col 19, line 24 to col 20, line 22).

Claim 25: Katz et al. discloses the method of claim 23, further comprising:

- a. receiving, in the computing system, a signal requesting processing for one or more promotions;
- b. replacing the first product with the second product when a replacement promotion is selected; and
- c. adding another product to the order when an enhancement promotion is selected.

Claim 25 is directed to the processing of the offer or promotion, a replacement product as the offer and an enhancement feature. Katz et al. teach the feature of a replacement product such as a new version of the software (col 24, line 45). Katz et al. teach the feature of presenting the offer in a website setting and consummating the order (col 25, line 10-12 and col 25, line 56). The signal is inherent, for example, the accessing a database is a signal and selecting an offer is a signal. Katz et al. teach the feature of a replacement product such as a new version of the software (col 24, line 45).

Claims 26 and 28 disclose the computer program on a readable medium of the method Claims 23 and 25 respectively. The prior art of Katz et al. as set forth above in Claims 23 and 25 is upon to reject Claims 26 and 28.

Claim 24: Katz et al. discloses the method of claim 23, but does not explicitly disclose wherein storing criteria for a promotional offer in a computer-readable memory comprises associating the first product identifier with one or more promotional codes.

Art Unit: 1796

Katz recites the use of promotional offers in the field of upselling and cross-marketing (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21). In particular, Katz et al. teach the feature of association a subset of offer based on the primary transaction (col 23, lines 40-60 and col 23, line 67 to col 24, line 1) and the feature of promotional/discount offers – coupon and promotional material (col 18, line 7 and col 23, line 43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Katz et al., with the use of promotional codes as the subset of offers since it was known in the art that promotions are identified by codes to provide a way of tracking the promotions.

Claim 27 discloses the computer program on a readable medium of the method Claims 24. The prior art of Katz et al. as set forth above in Claim 24 is upon to reject Claim 27.

#### B. Response to Appellant's Argument.

##### Appellant argues

With respect to claims 9 and 17, Appellant disagrees that the Katz et al. reference discloses “receiving, in a computing system, a signal identifying a first product associated with an order” (page 8); “associating a first product identifier with the first product” (page 9); and “presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier” (page 13).

##### Examiner's response

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claims as Appellant merely states that the Katz et al. reference does not teach the instant claims. Examiner respectfully disagrees because the Katz et al.

Art Unit: 1796

reference discloses a telemarketing method that is implemented in a computer network system in which a primary transaction/interaction [first step of claims 9 and 17] triggers an upselling opportunity that is based on data elements associated with the primary transaction/interaction [second step of claims 9 and 17] (see abstract; col 22, lines 31-45; col 23, line 63 to col 24, line 49; col. 26, lines 13-38 and Figs. 4-6). The Katz et al. reference defines the term "upsell" as "an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made. The term "upsell" is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as where an initial contact is for service or repair purposes" (col. 13, lines 38-47). The various upsells (i.e. a product or service related to the primary transaction) are presented to the user via the computer interface [third step of claims 9 and 17] (see abstract; col 22, lines 31-45; col 23, line 63 to col 24, line 49; col. 26, lines 13-38 and Figs. 4-6).

#### Appellant argues

With respect to claims 10 and 18, Appellant disagrees that the Katz et al. reference discloses "determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier" (page 16).

#### Examiner's response

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claim as Appellant merely states that the Katz et al. reference does not teach the step of the instant claim. Examiner respectfully disagrees because the Katz et al. reference discloses the telemarketing method in which the upsell is determined by inputs

Art Unit: 1796

associated with the primary transaction/interaction (col 22, lines 31-45; col 24, lines 31-49 and Fig. 6).

Appellant argues

With respect to claims 11 and 19, Appellant disagrees that the Katz et al. reference discloses “comparing the first product identifier with a list of product identifiers associated with promotional offers” (page 18).

Examiner’s response

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claims as Appellant merely states that the Katz et al. reference does not teach the step of the instant claim. Examiner respectfully disagrees because the Katz et al. reference discloses the telemarketing method in which the upsell is determined by inputs associated with the primary transaction/interaction and the various upsell items are offered to the customer (col 25, lines 5-10).

Appellant argues

With respect to claim 12, Appellant disagrees that the Katz et al. reference discloses “an arrangement wherein a promotion is associated with a combination of one or more product identifiers” (page 19).

Examiner’s response

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claims as Appellant merely states that the Katz et al. reference does not teach the step of the instant claim. Examiner respectfully disagrees because the Katz et al. reference discloses the telemarketing method in which the upsell is an “offer of a good or a

Art Unit: 1796

service, or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or a service” (col 18, lines 7-11 - also see col. 27, lines 17-21).

Appellant argues

With respect to claims 13 and 20, Appellant disagrees that the Katz et al. reference discloses “presenting one or more replacement products in the user interface” (page 20).

Examiner’s response

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claims as Appellant merely states that the Katz et al. reference does not teach the step of the instant claim. Examiner respectfully disagrees because the Katz et al. reference discloses the feature of offering replacement products in the upsell telemarketing method (col 27, lines 47-49).

Appellant argues

With respect to claims 23 and 26, Appellant disagrees that the Katz et al. reference discloses “storing criteria for a promotional offer in a computer-readable memory” (page 21); “receiving, in a computing system, a signal identifying a first product associated with a consumer order” (page 22); “comparing a first product identifier associated with the first product with the criteria for a promotional offer” (page 22); and “presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer” (page 23).

Examiner’s response



Art Unit: 1796

Examiner remarks that Appellant has not discuss the discrepancies between the Katz et al. reference and the instant claims as Appellant merely states that the Katz et al. reference does not teach the instant claims. Examiner respectfully disagrees because the Katz et al. reference discloses an adaptive telemarketing method that is implemented in a computer network system in which a primary transaction/interaction triggers an upselling opportunity that is based on previously stored data elements associated with the primary transaction/interaction (see abstract; col 22, lines 31-45; col 23, line 63 to col 24, line 49; col. 26, lines 13-38 and Figs. 4-6). The various upsells (i.e. a product or service related to the primary transaction) are presented to the user via the computer interface and the resulting responses to the various upsells are stored to optimize the system for future upselling opportunities (see abstract; col 22, lines 31-45; col 23, line 63 to col 24, line 49; col. 26, lines 13-38 and Figs. 4-6).

#### Appellant argues

With respect to claims 24 and 27, Appellant states the claim limitation of a promotional code is not obvious ant that the Office Action fails to cite any references to support the assertion of obviousness regarding the promotional code feature (page 25).

#### Examiner's response

Examiner respectfully disagrees because the Katz et al. reference teaches the future of providing promotional items such as coupons associated with the primary transaction, “[the uspsell is an] offer of a good or a service, or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or a service” (col 18, lines 7-11 - also see col. 27, lines 17-21) and it is well-known in the art to use a code such as a barcode as an identifier. It would have been obvious to

Art Unit: 1796

a skilled artisan in the marketing art to include code as a tracking feature to ensure proper matching and verification during redemption of the promotion.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/T. V. N./  
Examiner, Art Unit 1796

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622

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